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In re Application of
SANDLER et al.
Application No.: 08/959,054
PCT No.: PCT/EP96/02766
Int. Filing Date: 25 June 1996
Priority Date: 27 June 1995
Filing Date: 28 October 1997
Attorney's Docket No.: METAL1258-I
For: DEVICE FOR AUTOMATICALLY
EMPTYING A BULK CONTAINER

DECISION

This decision is in response to the "PETITION TO PROCESS APPLICATION AS A NATIONAL STAGE OF PCT APPLICATION" and applicants' communication filed 13 July 1999 requesting a "NOTIFICATION OF ACCEPTANCE UNDER 35 U.S.C. 371" (Form PCT/DO/EO/903), which have been treated as a petition under 37 CFR 1.181.

BACKGROUND

On 25 June 1996, applicant filed international application PCT/EP96/02766, which claimed a priority date of 27 June 1995. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 16 January 1997. A Demand for international preliminary examination, in which the United States was elected, was filed on 20 September 1996, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 29 December 1997 (27 December 1997 being a Saturday).

On 28 October 1997, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, a filing fee of \$700.00; a translation of the international application into English; a preliminary amendment; and a declaration. The application was processed as a filing under 35 U.S.C. 111(a).

DISCUSSION

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). The official PTO Notice published in the Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states, in part, the following:

The Patent and Trademark Office is continuing to receive application papers which do not clearly identify whether the papers (1) are being submitted to enter the national stage of the Patent Cooperation Treaty (PCT) under 35 U.S.C. 371 or (2) are being filed as a regular national application under 35 U.S.C. 111.

* * *

To clearly indicate an international application is being filed under 35 U.S.C. 371 the applicant should use the "Transmittal Letter for United States Designated Office" (Form PTO-1390) as the transmittal letter.

Alternatively, one of the following indications may be used:

- 1) the applicant shall clearly state in the transmittal or cover letter that he or she is filing under 35 U.S.C. 371 or entering the national stage under PCT; or
- 2) the applicant clearly identifies in the oath or declaration the specification to which it is directed by referring to a particular international application by PCT Serial Number and International Filing Date and that he or she is executing the declaration as, and seeking a U.S. Patent as, the inventor of the described in the identified international application.

The transmittal letter which accompanied the originally submitted application papers indicates that the items listed above were submitted "under 35 U.S.C. §371". No conflicting instructions appear in the application papers. Accordingly, the application should have been treated as a national stage application submitted under 35 U.S.C. 371.

35 U.S.C. 371(c) states:

- (c) The applicant shall file in the Patent and Trademark Office--
 - (1) the national fee provided in section 41(a) of this title;
 - (2) a copy of the international application, unless not required under subsection (a) of this section or already communicated by the International Bureau, and a translation into the English language of the international application, if it was filed in another language;
 - (3) amendments, if any, to the claims in the international application, made under article 19 of the treaty, unless such amendments have been communicated to the Patent and Trademark Office by the International Bureau, and a translation into the English language if such amendments were made in another language;

(4) an oath or declaration of the inventor (or other person authorized under chapter 11 of this title) complying with the requirements of section 115 of this title and with regulations prescribed for oaths or declarations of applicants;

(5) a translation into the English language of any annexes to the international preliminary examination report, if such annexes were made in another language.

As to 35 U.S.C. 371(c)(1), since the application was processed under 35 U.S.C. 111(a), applicants were charged the basic filing fee of \$790.00. The difference in the filing fee (\$790) and the basic national fee (\$930) where the European Patent Office was the International Searching Authority will be charged to applicant's Deposit Account No. 19-3869 as authorized in the Transmittal Letter. Thus, this requirement has been satisfied.

As to 35 U.S.C. 371(c)(2), a copy of the international application was previously communicated by the International Bureau. A translation of this application was filed with the 28 October 1997 submission ("A 7786" is type-written in the right hand corner of the title page of this translation).

As to 35 U.S.C. 371(c)(3), no amendments under PCT Article 19 appear to have been made. The Transmittal Letter filed 28 October 1997 indicates in items 5 and 6 that amendments under PCT Article 19 and translations of such amendments were filed. However, it appears that the Transmittal Letter is incorrect as the amendments and translations of such amendments accompanying it are amendments under PCT Article 34.

As to 35 U.S.C. 371(c)(4), a declaration of the inventors was submitted. However, this declaration does not appear to adequately identify the specification for the reasons set forth below.

As to 35 U.S.C. 371(c)(5), applicants filed two additional and different English language specifications on 28 October 1997. Each specification includes six claims, which is consistent with the amendments made to the international application under PCT Article 34. It is unclear which of these specifications is the English translation of the Annexes to the International Preliminary Examination Report (IPER).¹ The first of these specifications is stapled to the IPER. The second of these specifications contains what appears to be facsimile transmission information at the top of the page. The preliminary amendment filed 28 October 1997 corresponds to the second specification. As indicated above, these two specifications are not identical. For example, in the first paragraph on the first page of each of the translations, the first translation uses the terms "box-type" and "which can be" while the second translation uses the terms "box-shaped" and "capable of". Accordingly, applicants are required to identify which specification is the

¹Where a translation into the English language of the Annexes to the IPER is provided, the pages of the translation will be used to replace the corresponding originally filed application pages. MPEP § 1893.01(b)(2). In the above-identified application, the Annexes replaced all of the originally filed application pages.

English translation of the Annexes to the IPER, and to specify the purpose of the other specification.

Because these different specifications were filed, it is not clear which of these is referred to in the declaration which specifies the specification "which is attached hereto". Accordingly, the declaration fails to comply with 37 CFR 1.497(a).

CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.181 to process the application under 35 U.S.C. 371 is GRANTED.

Applicants are required to file a proper reply to this decision. A proper reply must: (1) identify which specification is the translation of the Article 34 amendments, (2) explain why a second specification which also appears to correspond to the Article 34 amendments was filed, and (3) file a new oath or declaration in compliance with 37 CFR 1.497(a)-(b), within a time limit of ONE (1) MONTH from the date of mailing of this decision. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper reply will result in abandonment of the application.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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